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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,528	02/25/2002	Mark W. Lambert	31008.P037	9800

26181 7590 05/15/2007
FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

SHARON, AYAL I

ART UNIT	PAPER NUMBER
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2123

MAIL DATE	DELIVERY MODE
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05/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/085,528	Applicant(s) LAMBERT ET AL.	
	Examiner Ayal I. Sharon	Art Unit 2123	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9,11-13 and 15-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9,11-13 and 15-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/8/07</u> . | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet.</u> |

Continuation of Attachment(s) 6). Other: Requirement for Info Under 37 CFR 1.105.

Introduction

1. Claims 1-9, 11-13, and 15-39 of U.S. Application 10/085,528, originally filed on 02/25/2002, are currently pending.
2. This action is accompanied by a separate non-final Office Action.
3. Applicants' response to this Requirement for Information must also address the issues raised in the accompanying non-final Office Action.

37 C.F.R § 1.105 – Requirement for Information

4. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.
5. The Examiner has located the following reference:
 - Zarrillo, Andrew. "Autodesk Licenses Constraint Management Technology." Business Wire. New York. Feb. 26, 1990. Sec.1, p.1. ("Zarrillo").
6. The press release teaches that Autodesk reached an agreement with D-cubed to license D-cubed's constraint manager, "DCM (dimensional constraint manager)."
7. Examiner notes that the date of the news article is Feb. 26, 1990, a full 12 years before the filing date of the instant application.
8. The specification of the instant application (see p.9, lines 13-21) teaches the following (emphasis added):

Except for the teachings of the present invention incorporated in the pattern determination engine 108, the mechanical design application 100 is intended

to represent a broad range of CAD software known in the art, including but not limited to Autodesk InventorTM, available from Autodesk, Inc. of San Rafael, California. Additionally, as alluded to earlier, the mechanical design application 100 may include parametric software components to provide parametric functionality, such as, but not limited to, **2D Dimensional Constraint Manager available from D-cubed, Ltd. of Cambridge, England.**

9. The Applicants filed an IDS on 3/8/07 that contained a January 2002 version of the manual for the 2D Dimensional Constraint Manager (DCM).
10. The 12 year gap between the date of the Zarrillo press release and the prior art submitted with IDS filed 3/8/07 raises the suspicion that the claimed features existed in the on-sale product over a year before the filing date of the instant application.
11. The prior art submitted with IDS filed 3/8/07 predates the filing date of the instant application by only one month. While the newly submitted prior art by itself is not old enough to qualify as a basis for a 35 USC § 102(b) on-sale bar rejection, it does not refute the prima facie case of an on-sale bar rejection based on the Zarrillo press release.
12. **The Applicant is required to provide either: (1) a copy of a manual that predates the filing date of the instant application by at least one year, or (2) a sworn affidavit explaining why the software sold prior to the 35 USC § 102(b) grace period would have been functionally unable to perform the claimed limitations.**

Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ayal I. Sharon whose telephone number is (571) 272-3714. The examiner can normally be reached on Monday through Thursday, and the first Friday of a bi-week, 8:30 am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Rodriguez can be reached at (571) 272-3753.

Any response to this office action should be faxed to (571) 273-8300, or mailed to:

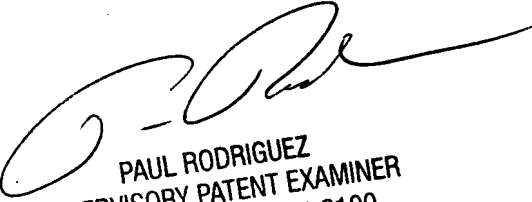
USPTO
P.O. Box 1450
Alexandria, VA 22313-1450

or hand carried to:

USPTO
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center 2100 Receptionist, whose telephone number is (571) 272-2100.

Ayal I. Sharon
Art Unit 2123
May 11, 2007


PAUL RODRIGUEZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100